



219.40441X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Combs et al

Serial No.: 10/032,329

Filed: December 31, 2001

For: ZERO MOUNTING FORCE SOLDER-FREE
CONECTOR/COMPONENT AND METHOD

Art Unit: 2833

Examiner: Gary Paumen

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed 10/31/02 containing a Restriction/Election requirement, Applicant respectfully submits the following in connection with the above-identified application.

RESTRICTION/ELECTION REQUIREMENT - TRAVERSED

A restriction/election requirement has been made for the reasons beginning on page 2 of the Office Action. Applicant respectfully traverses based upon the following grounds.

REASONABLE NUMBER OF SPECIES, WITH GENERIC CLAIM

The Examiner has taken the following position: " 1. The application contains claims directed to the following patentably distinct species of the claimed invention: species 1-10: Figures 2, (5A), (10A), 11, 12, 17, 21A, 22, 25, and 27, respectively. " (Emphasis Added)."

From the foregoing it appears that Examiner believes that there are ten (10) patentably distinct species. This finding is in error. There are three (3) species of the invention and only three species of the invention as now will be made evident from the analysis that follows.

In the matter of the Examiners assertion that Figure 2 is a patentably distinct species of the invention, attention is directed to paragraph [0045] which reads in part as follows:

"[0045] Attention is now directed to FIGS. 2, 3 and 4 which, when taken together along with an explanation that follows, will provide an understanding of a less advantageous arrangement involving a zero mounting force component 20 positioned above an aperture 21 in PCB 22....." From the foregoing it is clear that Figure 2 is not a species of the invention and further more there are no claims in the application that are directed to the structure of Figure 2.

Figure 5a noted by the Examiner, as well as, Figs. 5, 6, 6a, 7, 8, and 9 are all directed to Species #1 of the invention.

Figure 10a noted by the Examiner as well as Figs. 10, 10b, and 11 are all directed to Species # 2 of the invention. Accordingly Figures 10a and 11 are not separate species. These two figures illustrate separate physical aspects of the Species # 2 and are not separate species.

Figure 12 identified by the Examiner as a separate patentably distinct species is in fact simply illustrative of the nature of oval pins 36 and oval openings 41' of an embodiment of the invention depicted in Figs 5, 5a, 6, 6a, 7, 8, and 9 as noted hereinbefore.

Figure 17 cited by the Examiner as a patentably distinct species, as well as, Figs. 18, 19, and 20 are directed to a less advantageous rotating wedge connector as indicated in paragraphs [0028] thru [0031] in the specification. Accordingly Fig 17 is not a patentably distinct species of the invention as the Examiner has asserted.

Figures 21, 21a, 22, 23, 24, 25, 26, and 27 are directed to and illustrate various physical aspects of a Species # 3 that embodies the subject invention.

It follows therefore that the Examiners assertion that Figs. 21a, 22, 25, and 27 are patentably distinct species of the invention is in error for the reasons set forth next above.

By way of summary the subject patent application includes only three (3) species of the same invention and not ten (10) patentably distinct inventions as the Examiner maintains.

As traversal, 37 CFR §1.141 provides that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one application providing the application also includes an allowable generic claim to all of the claimed species and all claims to the species in excess of one are written in dependent form or otherwise include the limitations of an allowable generic claim.

Applicant believes that claims 1,2,3,4,5,6,7,8,9,10,11,12,25,26,27,28, and 29 presently in this application are allowable and are generic, and that all other pending claims contain the limitations of such generic claims, Applicant respectfully submits that the election of species requirement should be withdrawn and all claims considered and allowed.

NOT INDEPENDENT AND DISTINCT INVENTIONS

As traversal, Applicant notes that 35 USC §121, the basis for a restriction and election of species requirement, provides for a restriction only if two or more independent and distinct inventions are claimed in one application. While §802.01 of the Manual of Patent Examining Procedure indicates that restriction and/or election of species may be permissible between independent or distinct inventions, such section of the Manual of Patent Examining Procedure is clearly erroneous in view of the plain and unambiguous language of 35 USC §121.

In this connection, the above-noted section of the Manual of Patent Examining Procedure defines the term "independent" as meaning there is no disclosed relationship between the two or more subjects disclosed that is, they are unconnected in design, operation or effect. It is respectfully submitted that a contention cannot validly be made that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention have no disclosed relationship, for if such is the case, such contentions are clearly without merit as a review of the instant specification and the claimed subject matter reveals. More particularly, to show that Applicant's claims are related, Applicant respectfully submits the following comments.

The invention in this application is directed to a zero force solder-free connector component that utilizes rotary pins that bind in corresponding openings of a PCB when the oval pins are rotated. There are a number of different mechanisms that may be employed to rotate the pins, three (3) of which are shown and appear as dependent claims in this application.

With further regard to the erroneous restriction/election position presented in the Manual of Patent Examining Procedure (*i.e.*, teaching restriction/election for "independent or distinct inventions", instead of the unambiguous "independent and distinct inventions" statutory language), as pointed out by Mr. McKelvey in the concurring opinion in *ex parte Hartmann*, 186 USPQ 366 (Bd. App. 1974), relying upon the Decision of *ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966) the Manual of Patent Examining Procedure merely provides guidelines for Examiners in the Patent Office and it does not replace, and is subservient to, applicable statutes, Rules of Practice, and prior decisions. Thus, it would appear that by virtue of the plain and unambiguous language of 35 USC §121, the statute only permits an election of species requirement between two or more independent and distinct inventions (not independent or

distinct inventions) in spite of the circumlocutory argumentation of §802.01 of the Manual of Patent Examining Procedure.

Furthermore, in view of the interrelationship of the inventions designated in the Office Action, and in view of the fact that each of the designated inventions are, in essence, based upon the same basic inventive concept, Applicant respectfully submits that the designated inventions are not independent and distinct to the extent required by 35 USC §121 to support a restriction requirement. In this connection, Applicant notes that a basic inventive concept of the claims in issue relates to a zero force solder-free connector component that utilizes rotary pins that bind in corresponding openings of a PCB when the oval pins are rotated. Three different mechanisms are illustrated and may be employed to rotate the pins.

Applicant respectfully submits that these differences should not be considered as rendering the respective embodiments independent and distinct to the extent required by 35 USC §121.

In summary, a review of the Office Action reveals that the Office Action has failed to clearly indicate how the subject matter recited in the respective groups of claims represents both independent and distinct inventions are required by 35 USC §121.

RELATED INVENTIONS - NO SERIOUS BURDEN FOR EXAMINATION

As traversal, presuming *arguendo* that one could establish that the subject matter recited in the claims in issue relating to the respective embodiments of the present invention relate to independent and distinct inventions as required by 35 USC §121, as pointed out in §803 of the Manual of Patent Examining Procedure, if a search and an examination of an entire application can be made without serious burden, the Examiner must examine the application on the merits even though the application includes claims to distinct or independent inventions. A review of

the Office Action reveals that such Office Action has failed to provide any indication as to how or why a search and examination of an entirety of the claims in the instant application would create a serious burden on the part of the United States Patent and Trademark Office. In fact, it is respectfully submitted that a serious burden cannot be shown at this time owing to the fact that the claims are related as mentioned above.

PROVISIONAL ELECTION

In order to comply with the election of species requirement, Applicant provisionally elects, with traverse, for prosecution on the merits, Species # 3, of Figs.21, 21a, 22, 23, 24, 25, 26, and 27, including at least claims 13, 17, 18, 19, 21, 22, 23, and 24.

NO ADMISSION - RESTRICTION/ELECTION

Applicant submits that the instant response (including the comments submitted and the provisional election) is not an admission on the record that the respective species are separately distinct species and/or obvious variants.

EXAMINER INVITED TO TELEPHONE

The Examiner is herein invited to telephone the undersigned attorneys at the local Washington, D.C. area telephone 703-312-6600 to discuss an Examiner's Amendment or any other suggested actions for accelerating prosecution and moving the present application to allowance.

CONCLUSION

This Response is being filed within the one month shortened statutory period set by the Office Action mailed 10/31/02, and therefore, no Petition for extension of time or fee is required. To whatever other extent is actually necessary, Applicant petitions for an extension of time under 37 C.F.R. §1.136. Please charge any shortage in the fees

Coombs et al

219.4044X00

due in connection with the filing of this paper to ATS&K Deposit Account No. 01-2135

(as Case No. 219.40441X00)

Respectfully submitted,



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